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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,446	06/05/2001	Davin J. Fifield	43576.830012.US1	5057

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09/22/2005

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EXAMINER
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SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/875,446

Applicant(s)

FIFIELD ET AL.

Examiner

Gautam Sain

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

- 1) This is a Non-final rejection in response to arguments filed on June 28, 2005.
- 2) The Examiner introduces the Kocher reference.
- 3) Claims 1-20 are pending and rejected in this action.

***Claim Rejections - 35 USC § 103***

- 4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4-1) Claim 1, 3-6, 7, 8, 9, 11-15, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithies et al (US 6091835, filed Feb 1998), in view of Kocher (US 6901509, filed Feb 2000).**

**Regarding claim 1, 7, 8, 9, 17 and 19, Smithies teaches a**  
*computer useable medium and computer readable code embodied on said computer useable medium for causing electronically signing an electronic transcript by a user, the computer readable code comprising (ie., method and system for recording ... transcripts ... party's electronic affirmation of a document... )(col 7, Summary section);*

**Smithies teaches**  
*providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data (ie., Evidence ... Affirmation ... time ... transcript generator ... time stamp ... affirming party)(col 13, line*

52 – col 14, line 4)(col 14, lines 18-20 talk about using timestamp as evidence, which must inherently be recorded along with the record if it is to be proper evidence);

*obtaining a notary record from the digital notary service of the time stamping (ie., transcript object ... validity of affirmation process ... later use in verifying ... passed to client)(col 14, lines 48-60)(ie., the fact that the timestamp is used as evidence shows a record of when the timestamp was placed with the record)(col 14, line 1-5);*

*digitally signing the notary record (ie., ... Act of signing ...)(col 13, lines 52-67)(col 1, line 22; col 5, line 16 further shows signing of electronic document using digital pen);*

*forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user (ie., client sends affirmation information to the transcript generator ... in lie 50 or col 14, the recording function gathers all the evidentiary components)(col 13, line 52 - line 67; col 6, lines 60-67).*

Smithies does not teach, but Kocher teaches

*performing a first hash operation on the electronic transcript to generate a representation of the contents of the electronic transcript (ie., constructing a hash tree as an interval hash tree)(col 4, lines 9-12);*

*concatenating data to the representation of the contents of the electronic transcript, said data identifying a user (ie., set the terms of document ... transcript generator ... creates secure record)(col 12, lines 28-40)(ie., evidence to corroborate ... transcript generation module collects)(col 13, lines 52-60)(see Fig 4b, item 518 shows a*

GUI that starts the process for gathering (equivalent to concatenating) data that represents the electronic transcript, upon approval, the data entered/verified is gathered);

*performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data (ie., hashing the result of concatenating the next hash with R, with cryptographic hash functions)(col 10, lines 15-25).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smithies to include hashing the result of concatenating the next hash with the hash tree with cryptographic hash functions as taught by Kocher, providing the benefit of demonstrating and confirming the status of a digital certificates and other data on a computer-implemented method (Kocher, Abstract section):

**Regarding claim 3, 11,** Smithies teaches “data includes ... user” (ie., affirming party ... identifying party entering affirming data ... password)(col 7, lines 23-30).

**Regarding claim 4, 12,** Smithies teaches “data includes ... the user” (ie., ... unique secret number ... )(col 7, lines 45-50).

**Regarding claim 5, 13,** Smithies teaches “data includes ... name” (ie., ... party’s name)(col 7, lines 50-52).

**Regarding claim 6, 14,** Smithies teaches “data ... identifies the transcript”(ie., identification data by system that transcript generator collects)(col 13, lines 52-60).

**Regarding claim 15,** Smithies teaches “ file contains ... transcript” (ie., transcript object can be encrypted in a statement file)(col 8, lines 25-30).

**4-2) Claims 2, 10, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithies et al (as cited above), in view of Kocher (as cited above), further in view of Blake-Wilson et al (US 6336188, filed May 1998).**

**Regarding claim 2, 10,** Smithies does not teach, but Blake-Wilson teaches “has operation is a RIPEMD-160 hash operation” (ie., hash function ... RIPEMD-160)(col 5, lines 25-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smithies to include RIPEMD hashing as taught by Blake-Wilson, providing the benefit of authentication key agreement protocols used in digital data communication systems (Blake-Wilson, col 1, lines 4-5, lines 60-65).

**Regarding claims 16, 18, 20,** Smithies teaches “file excludes page numbers, line numbers, headers, and footers” (ie., the transcript file does not indicate the presence of page numbers, line numbers, headers or footers)(Summary section). Additionally, has been very common to one of ordinary skill in the art at the time of the invention to use word processor software applications (ie., Microsoft Word,... etc) that allow for toggling page number, line numbers, headers and footers off and on depending on the user's choice.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues the Smithies does not teach performing a first hash operation on the electronic transcript to generate a representation of the contents of the electronic transcript; concatenating data to the

representation of the contents of the electronic transcript, said data identifying a user; performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data. Examiner agrees, and introduces the Kocher reference to teach this limitation in conjunction with Smithies. Applicant argues that Smithies does not teach providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data. Examiner disagrees, Smithies teaches the evidence to corroborate the act of signing or affirmation with transcript generator module (col 13, line 52 – col 14, line 4). Applicant argues that Smithies does not teach obtaining a notary record from the digital notary service of the time stamping. Examiner disagrees. Smithies teaches where the affirming party's input in verifying time stamp when affirming (col 14, lines 1-2). Applicant argues that Smithies does not teach digitally signing the notary record. However, Examiner disagrees because Smithies does teach signing of electronic document using digital pens (col 1, line 22; col 5, line 16). Applicant argues that Smithies does not teach forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user. The Examiner disagrees because Smithies does teach capacity to generate a comprehensive transcript record of the fact and circumstances associated with the party's actions as they sign an electronic document including identifying the signer (col 6, line 60-67; col 13, lines 52-60). The dependent claims are rejected based on their dependency of the rejected claims and their detailed rejections set forth above. With a

broad reasonable interpretation of the claim, the Examiner asserts that Smithies in view of Kocher teach all the limitations.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GS.

GS

*William L. Bashore*

**WILLIAM BASHORE  
PRIMARY EXAMINER**

*9/17/2005*